Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation. Conversions to digital in Cooper are done to provide "a single serial bit stream to convey the input signal, no matter what the input signal form". Col. 4, lines 6-9. In claim 9, digital audio data is received. Also, in Cooper, "it is preferred that the format of the output signal match the format of the input signal" Col. 4, lines 11-12. Note that the formats are referenced. There is no discussion of conversion based on "desired converter quality". Formats cannot be directly equated to quality.

Further, there is no mention of a personal computer in Cooper. In fact, Cooper relates to complex television systems, not to audio processing in a personal computer. The Office Action indicates that "Cooper teaches that a method of routing digital audio to a plurality of digital-to-analog converters in a personal computer...". As indicated above, Cooper relates to complex television systems, not personal computers. Thus, an initial assumption about the teaching of Cooper in the Office Action is incorrect. As each and every element is not shown in the reference, the rejection should be withdrawn.

Claim 11 is also believed to distinguish from Cooper. Claim 11 positively recites, "assigning digital audio data from each source a priority". Cooper only mentions, "providing emergency alternate connection...if a higher priority input came available or active." Col. 5 lines 30-33. There is no mention of assigning a priority. Apparently, the priority already exists, and is not assigned in Cooper. Further, there is no mention of a personal computer in Cooper. Thus, a prima facie case of anticipation has not been established and the rejection should be withdrawn.

Claim 13 also recites a personal computer, and references conversion based on quality, neither of which are found in Cooper. Since all the elements are not shown or inherent in Cooper, the rejection should be withdrawn.

§103 Rejection of the Claims

Claims 1-3, 5-6, 7-8 and 12 were rejected under 35 USC § 103(a) as being unpatentable over Hewitt (US 5,896,291) in view of Cooper (US 5,592,508). This rejection is respectfully traversed.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

> In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the

same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness as each and every element of the rejected claims is not shown or suggested in the references, either alone or combined. Regarding claims 1, 5, 6, 7 and 8, Hewitt does not teach multiple D-A converters as stated by the Office Action. A single DAC 206 is discussed. However, a DAC accumulators 212 and one or more effects accumulators 214 are also shown in Figure 2, but these are not a D-A converters. Thus, Hewitt only shows one digital-to-analog converter. As seen in Figure 2, the accumulators 212 and 214 indirectly feed into DAC 206. Thus, DAC 206 always provides the output, and there is no way to select another converter.

Regarding claim 2, the above arguments with respect to Cooper not teaching or suggesting selection based on quality apply equally. Still further, since Cooper does not discuss the use of a personal computer, there is no suggestion to combine it with Hewitt. However, even if combined, routing of signals to different converters based on quality is simply not taught or suggested. As no prima facie case of obviousness has been established, the rejection should be withdrawn.

Claims 4 and 10 were rejected under 35 USC § 103(a) as being unpatentable over Hewitt (US 5,896,291) and Cooper (US 5,592,508) as applied to claims 1 and 9 above, and further in view of Silberschatz. This rejection is respectfully traversed. Claim 4, which dependends from claim 1 distinguishes over Hewitt and Cooper as indicated in the remarks corresponding to the rejection of claim 1. Silbershchatz is not cited as teaching the elements not shown by the combination of Hewitt and Cooper. As such, prima facie case of obviousness has been established, the rejection should be withdrawn.

Claim 10 depends from claim 9, which was also distinguished from Cooper. Neither Hewitt nor Silberschatz provide the elements missing from Cooper with respect to claim 9. As such, a prima facie case of obviousness has been established, the rejection should be withdrawn.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 25th day of September, 2002.

Candis B. Buending
Name

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Signature